

REMARKS

Applicants request favorable reconsideration of this application in view of the foregoing amendments and the following remarks. Claims 16-34 were pending in the application and were rejected in the Office Action. By way of this amendment, Applicants have: (a) amended claims 16, 29, and claim 34; and (b) canceled claim 30. Accordingly, claims 16-29 and 31-34 are respectfully presented for further consideration.

Entry and consideration of this Amendment is respectfully requested because it raises no new issues and does not warrant a further search. Specifically, the amendments made to claim 16 were derived from limitations previously recited in dependent claims 29 and 30. Claim 34 was amended in a manner similar to claim 16.

1. Rejections of Claims 16-34

The Examiner again rejected:

- (a) claims 16-18, 20, 28, 29, 31, and 32 under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 6,214,266 (“Millif”) and claims 30 and 33 under 35 U.S.C. § 103(a) as allegedly being obvious in view of Millif;
- (b) claims 19 and 34 under 35 U.S.C. § 103(a) as allegedly being obvious when considering Millif in view of U.S. Patent No. 6,568,707 (“Hier”);
- (c) claims 21, 24, and 25 under 35 U.S.C. § 103(a) as allegedly being obvious when considering Millif in view of U.S. Patent No. 6,231,940 (“Aichner”);
- (d) claims 22, 26, and 27 under 35 U.S.C. § 103(a) as allegedly being obvious when considering Millif in view of U.S. Patent No. 6,468,458 (“Anderson”); and
- (e) claim 23 under 35 U.S.C. § 103(a) as allegedly being obvious when considering Millif in view of E.P. Patent No. 1,329,302 (“Cooper”).

Preliminarily, the aforementioned rejection of claim 30 is now moot due to its being incorporated into claim 16. Accordingly, Applicants respectfully traverse each of these rejections with respect to claims 16-29 and 31-34.

Independent claim 16 (*i.e.*, the claim from which claims 17-29 and 31-33 depend) recites a manufacturing method of a cross member, which is configured to extend in a width direction of a vehicle body and which is configured to have both ends connected to side framework structures of the vehicle body. This method includes, among other possible steps (*italic and bold emphases added*):

forming, from a material, a base frame extending in the width direction of the vehicle body by means of resinous molding, **the base frame being formed to have a substantially circular or oval cross-section;**

forming a plurality of bosses on an outer circumferential surface of the base frame in different positions in an axial direction of the base frame and arranged so that each of the bosses is located in a different cross-section perpendicular to the axial direction of the base frame; and

insert-molding the base frame, within limited ranges thereof in the width direction of the vehicle body, in resinous material belonging to a same material system as the material of the base frame, thereby forming reinforcing frame parts integral with the base frame, **the reinforcing frame parts being molded to have substantially circular or oval cross-sections.**

Similarly, claim 34 recites a manufacturing method of a cross member, which is configured to extend in a width direction of a vehicle body and which is configured to have both ends connected to side framework structures of the vehicle body. This method includes, among other possible steps (italic and bold emphases added):

resinous molding a base frame from a resinous material of a class of resinous materials, **the base frame being molded to have a substantially circular or oval cross-section**, wherein the base frame is configured to extend in the width direction of a vehicle body;

forming a plurality of bosses on an outer circumferential surface of the base frame in different positions in an axial direction of the base frame and arranged so that each of the bosses is located in a different cross-section perpendicular to the axial direction of the base frame; and

insert-molding limited ranges of the base frame in a resinous material of the material class of the base frame, thereby forming reinforcing frame parts integral with the base frame, **the reinforcing frame parts being molded to have substantially circular or oval cross-sections,**

wherein the resinous material of the reinforcing frame parts is higher in rigidity than the resinous material of the base frame.

For at least the following reasons, no combination of Millif, Hier, Aichner, Anderson, and/or Cooper teaches or suggests the methods recited in claims 16 and 34.

In the Office Action, the Examiner stated:

the method steps (i.e. molding steps) of the claim are not affected by changing the cross section of the frame parts. To be entitled to weight in method claims, recited structural limitations must affect the method in a manipulative sense and not amount to mere claiming of a use of a particular structure.

See Office Action at pp. 2-3 (citing *Ex parte Pfeiffer*, 135 U.S.P.Q. 31), see also Office Action at p. 4 (justifying a rejection of claims 30 and 33 on similar grounds) and p. 5

(justifying a rejection of claim 34 on similar grounds). In contrast to the Examiner's assertion, the recitation (in the "wherein" clauses previously in claims 16 and 34) that the cross-sections are "substantially circular or oval in shape" did not "amount to mere claiming of a use" of the structure. Rather, the "wherein" clauses described physical aspects of the structure. In other words, the wherein clause positively defined (and, therefore, limited) the result of the first base frame "forming" (claim 16) and "molding" (claim 34) steps. The only arguable statements in these claims of intended use are in the claims preambles, which, of course, are not entitled to patentable weight. As a result, *Ex parte Pfeiffer* is inapplicable and, therefore, the "wherein" clauses should have been given patentable weight. However, to crystallize this point and to advance prosecution, Applicants have opted to move the limitations of the "wherein" clauses into the recited steps, as above-bolded in claims 16 and 34; in both claims this amendment is intended to be non-narrowing and not to affect the scope of the claims. For this reason alone, claim 16 (and each of its dependent claims) and claim 34 remain allowable over Millif, Hier, Aichner, Anderson, and Cooper for the reasons asserted in the response filed on May 10, 2005.

In addition, Applicants have also opted to advance prosecution by amending claims 16 and 34 to include the above-italicized limitations, which were derived from limitations previously recited in claims 29 and 30. Whereas the Examiner refused to give the above-italicized limitation patentable weight when rejecting claim 30 (*see* Office Action at p. 4), for the reasons previously stated, this limitation is entitled to patentable weight. As none of Millif, Hier, Aichner, Anderson, and Cooper teaches or suggests the above-italicized limitation, claims 16 and 34 are also allowable over Millif, Hier, Aichner, Anderson, and Cooper for at least this additional reason.

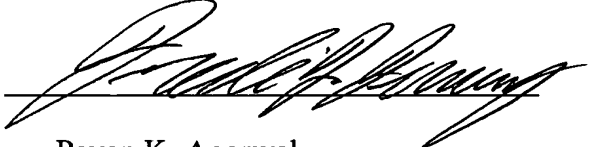
In light of the foregoing, it is clear that none of Millif, Hier, Aichner, Anderson, and Cooper teaches or suggests: (a) forming/molding a base frame and reinforcing frame parts that have substantially circular or oval cross-sections; or (b) forming a plurality of bosses on an outer circumferential surface of the base frame, each in a different cross-section, as recited in claims 16 and 34. Accordingly, no combination of Millif, Hier, Aichner, Anderson, and Cooper can be used to reject claims 16 or 34, or any claim dependent thereon, under 35 U.S.C. §§ 102(b), 103(a). Moreover, as claims 17-29 and 31-33 depend from claim 16, each of these dependent claims is also allowable over of Millif, Hier, Aichner, Anderson, and Cooper, without regard to the other patentable limitations recited therein. Accordingly, a withdrawal of the various rejections of claims 16-29 and 31-34 is both warranted and respectfully requested.

2. Conclusion

For the aforementioned reasons, claims 16-29 and 31-34 remain in condition for allowance. A Notice of Allowance at an early date is respectfully requested. The Examiner is invited to contact the undersigned if such communication would expedite the prosecution of the application.

Respectfully submitted,

Date JAN 31 2006

By 

Customer Number: 22428

FOLEY & LARDNER LLP

3000 K Street, N.W.

Suite 500

Washington, D.C. 20007-5143

Pavan K. Agarwal

Registration No. 40,888

Frederic T. Tenney

Registration No. 47,131

Telephone: (202) 672-5300

Facsimile: (202) 672-5399

Attorneys for Applicants

THE COMMISSIONER IS HEREBY AUTHORIZED TO CHARGE ANY ADDITIONAL FEES WHICH MAY BE REQUIRED REGARDING THIS APPLICATION UNDER 37 C.F.R. §§ 1.16-1.17, OR CREDIT ANY OVERPAYMENT, TO DEPOSIT ACCOUNT NO. 19-0741. SHOULD NO PROPER PAYMENT BE ENCLOSED HERewith, AS BY A CHECK BEING IN THE WRONG AMOUNT, UNSIGNED, POST-DATED, OTHERWISE IMPROPER OR INFORMAL OR EVEN ENTIRELY MISSING, THE COMMISSIONER IS AUTHORIZED TO CHARGE THE UNPAID AMOUNT TO DEPOSIT ACCOUNT NO. 19-0741. IF ANY EXTENSIONS OF TIME ARE NEEDED FOR TIMELY ACCEPTANCE OF PAPERS SUBMITTED HERewith, APPLICANT HEREBY PETITIONS FOR SUCH EXTENSION UNDER 37 C.F.R. § 1.136 AND AUTHORIZES PAYMENT OF ANY SUCH EXTENSIONS FEES TO DEPOSIT ACCOUNT NO. 19-0741.